

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

All claims have been rejected under 35 U.S.C. §112 on the basis of multiplicity. The Examiner submits that 25 claims are adequate to define the present invention. Applicants respectfully and strongly disagree and traverse the present rejection.

As noted in the rejection, MPEP 2173.05(n) governs the propriety of a rejection based upon multiplicity. In order for a rejection based upon multiplicity to be proper, at least two factors must be considered:

- The first factor is the "nature and scope of applicant's invention".
- The second factor is whether "applicant presents an unreasonable number of claims which ...are repetitious and multiplied, the net result of which is to confuse rather than to clarify" the invention.

MPEP 2173.05(n) further notes that "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. ... Undue multiplicity rejections based on 35 U.S.C. §112, second paragraph, should be applied judiciously and should be rare." (Case citations omitted, Emphasis added)

The following statistics may be of interest in determination of this issue. These statistics are approximate as determined by search of the USPTO patent search database as of March 17, 2006:

- PAIR indicates that the present invention is classed in class 348.
- In class 348, slightly more than 1% of issued patents appear to have at least 100 claims – apparently about triple the rate of the overall average.
- In class 348, approximately 3.2% of issued patents appear to have at least 50 claims (i.e., nearly ten times as many patents as noted in the Office Action, with double the number of

Application No.: 09/955,397

claims required by the Office Action).

- Note that issued patents will have already potentially undergone restriction, election and claim cancellation or withdrawal, hence, at first examination the number of claims in the above patents was quite frequently larger, and perhaps much larger.
- The present examiner appears to have examined and issued at least five patents with greater than 50 claims, at least one of which issued with 92 claims (6,868,402), and another of which issued with 173 claims (starting at 185 claims as filed – 6,766,307). The undersigned was unable to readily examine the file wrapper of each of these cases, but where he was able to, found no indication of an undue multiplicity rejection.
- Almost 13% of pending applications have 50 or more claims.
- About 4.5% of pending applications have 75 or more claims.
- Numerous examples of patents can be found in the field of electronic commerce that have not been rejected on this basis and which have large numbers of claims (e.g., 6,684,189 has 887 claims).
- Numerous recently issued patents contain large numbers of claims, for example, Patent 7,020,508 issued on March 28, 2006 with 222 claims, for example.

In view of the above, while the undersigned concedes that 100+ claims is not the norm, it is certainly not without precedent – including recent precedent, patent classification precedent and precedent with the present Examiner. In fact, it is clear that greater than 50 claims is rather common, and greater than 75 claims is far from unusual. It is further clear that inventions classified in class 348 commonly have many more claims than the averages cited in the Office Action.

The Office Action submits that 25 claims are adequate to protect the present invention, but provides no basis for such a conclusion, while the above data clearly indicates that applications having three times this number of claims are not at all unusual. While the undersigned appreciates and respects that the Examiner is a Primary Examiner with substantial patent examination experience, and is furthermore sympathetic to the burden that large numbers of claims place on the Examiner, the undersigned is charged with protection of Applicants'

Application No.: 09/955,397

invention. The undersigned submits that inventions in the present technology area are extremely difficult to adequately protect for the client – even with large numbers of claims because portions of such inventions are commonly carried out at various locations, in various forms, by various entities. Hence, by virtue of the nature and scope of Applicant's invention, 25 claims is wholly inadequate and arbitrary, and 102 claims is not excessive.

The nature and scope of Applicants' invention creates a jurisdictional challenge with protection of the invention. Jurisdictional and other challenges such as the following (by way of example) are common in electronic commerce related inventions*:

- claims to a server device can be circumvented by locating the server in another country;
- claims to methods carried out on the server device can be circumvented by locating the server in another country;
- claims to methods carried out by a client device may not be useful if one must sue a potential customer for relief;
- claims to the client device may not be useful if one must sue a potential customer for relief;
- storage media claims may be difficult to detect or enforce if only a potential customer owns the storage media;
- transmission media claims are not currently being considered statutory by the USPTO;
- signal claims are not currently being considered statutory by the USPTO; and
- system claims will often not literally read on actions or hardware of a single entity – often both the customer (client side) and the server operator (server side) together are required to meet all claim limitations.

MPEP 2173.05(n), quoting from several cases (citations omitted), indicates that Applicant should be allowed "reasonable latitude" in number of claims, and a rejection on undue multiplicity "should be applied judiciously, and should be rare." A determination of the appropriateness of such a rejection should be made "in view of the nature and scope of applicant's

* The list that follows is intended to be illustrative of the problems of claiming this general type of invention and not necessarily problems associated with claiming this particular invention.

invention.” The nature of Applicant’s invention as noted above is clearly not conducive to a multiplicity rejection solely on the basis of the number of claims currently presented.

In addition to the above, the Courts are handing down an ever changing range of determinations as to claim interpretation, leading to substantial uncertainty as to how claims will be interpreted in the future – possibly fifteen years or more into the future. The only defense against this is presentation of claims drafted using multiple claim drafting tools and multiple claim types and language including:

- “means + function” language claims
- elemental language claims
- method of operation claims
- method of use claims
- apparatus claims
- storage medium claims

Moreover, in the post Festo world, the claim drafter must be ever mindful of the consequences of claim narrowing. Presentation of large numbers of claims of varying scope may be one of the few mechanisms available to assist in preserving some level of equivalence under the doctrine of equivalence.

And, failure to claim that which has been disclosed is deemed to be a dedication of that subject matter. Hence, the present requirement amounts to a requirement that Applicant give up potential patent protection on his invention. Clearly, this is an improper requirement in the absence of establishment of *prima facie* unpatentability of the invention in view of the prior art.

Additionally, compact prosecution is designed to permit an Applicant to present a range of claims from broad to narrow during prosecution in an effort to expedite identification of patentable matter. Given all of the above factors, large numbers of claims are, unfortunately, one of the few mechanisms available to try to assure that Applicants’ technology is protected.

Finally, it is noted that Applicants did not present these claims free of charge. The U.S. Patent Office received \$3226 for examination of claims – at the price established by law and applicable at the time of filing. It is further noted that cancellation of claims will not result in a

Application No.: 09/955,397

refund. In short, Applicants are entitled to examination of the claims that they paid for.

In view of the above, it is respectfully submitted that 102 claims, while not a small number, is not extraordinary for this field of technology, and does not rise to the level of beclouding definition in a maze of confusion. The present number of claims is appropriate (and in fact, probably low) because:

- The present Examiner has examined applications with more claims, without such a rejection, so presentation of such a rejection here would appear to be an unfair and arbitrary application of the rule.
- Patents commonly issue with as many or more claims, so this rejection is further believed to constitute an unfair singling out of the present application.
- 25 claims is wholly inadequate to fully define the present invention by virtue of the nature and scope of the invention.
- MPEP indicates such rejections should be rare and applied judiciously.
- Jurisdictional issues dictate more claims.
- Uncertainty in claim interpretation dictates more claims.
- Compact prosecution suggests presentation of a broad range of claims.
- Applicants have paid the required fee for this examination.
- Festo and the demise of the Doctrine of Equivalence dictate more claims.

Hence, the rejection fails on the first factor required by the MPEP and noted above since the nature and scope of the invention demands a broad selection of claims.

Regarding the second factor required by the MPEP and noted above, it is noted that the presence of a large number of claims, in and of itself, is not adequate to permit a multiplicity rejection. The claims must also "obfuscate", "confuse" and "becloud" the claimed invention. While the Office Action asserts this to be the case, the only reasoning given is the actual number of claims presented. The Office Action fails to show how the claims obfuscate, confuse or becloud the invention. Hence, the rejection fails on the second factor required by the MPEP.

In view of this, while Applicants sincerely regret the burden of examination of the present claims, Applicants respectfully submits that the present rejection is improper. However,

Application No.: 09/955,397

in order to provide a complete response, Applicants select claims 84-101, but respectfully decline to cancel any claims at this time in the absence of a ruling by the Board of Appeals compelling same. However, Applicants sincerely hope to resolve this issue by discussion of the matter with the Examiner prior to further action on the merits.

Interview Request

The undersigned would, appreciate the opportunity to discuss this matter personally or over the telephone with the Examiner. Examiner Reagan spoke with the undersigned briefly on this date regarding the present response. Applicants appreciate the courtesies extended during that telephone conversation and request a further discussion of this matter after Examiner Reagan has had an opportunity to review this response. In preparation for such an interview, Applicants note that the claims can be categorized for discussion in the following manner:

1. Claims 1-20, 38-45 and 63-70 are method claims relating generally to delivery of digital content. Claims 21-22, 46-47 and 71 are storage media claims that closely track those in 1 above. (41 claims total)
2. Claims 23-35, 48-61 and 72-78 are method claims relating to a customer's purchase or acquisition of content or rights thereto. Claims 36-37, 46-47 and 79 are storage media claims that closely track those of 3 above. (30 claims total)
3. Claims 80-82 are related to a method of storing A/V content. Claim 83 is a storage medium claim that closely tracks those of 5 above. (4 claims total)
4. Claims 84-93 and 94-101 are related to an electronic commerce servers and similar devices. (19 claims total)

Concluding Remarks

In view of this communication, examination on the merits of all claims is believed to be appropriate, and such is respectfully requested at an early date. The undersigned respectfully requests an interview to resolve this matter. The undersigned can be reached at the telephone number below.

Application No.: 09/955,397

Respectfully submitted,



Jerry A. Miller

Registration No. 30,779

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Please Send Correspondence to:
Jerry A. Miller
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337

Application No.: 09/955,397